

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

VOIP-PAL.COM, INC.

Plaintiff,

v.

T-MOBILE USA, INC.

Defendant.

Civil Action No. 6:21-cv-674-ADA

ORDER GRANTING-IN-PART
VOIP-PAL'S MOTION TO COMPEL DEPOSITION OF NAYLA HAMADE

Before the Court is a discovery dispute between Plaintiff VoIP-Pal.com, Inc. ("VoIP-Pal") and Defendant T-Mobile USA, Inc. ("T-Mobile"). The issue presented is whether T-Mobile should be compelled to produce Nayla Hamade for a deposition regarding facts introduced after the close of fact discovery. Following submission of the parties' discovery dispute chart to the Court on August 30, 2023, the Court held a hearing on September 5, 2023 to address this dispute.

VoIP-Pal's Position

The Court should compel T-Mobile to produce Nayla Hamade for a deposition concerning her conversations with T-Mobile's technical expert (EX1) and her declaration (Dkt. 175-1) because her hearsay statements and testimony introduce new facts regarding HotSpot@Home, T-Mobile's lone prior art reference, that T-Mobile failed to disclose during fact discovery. VoIP-Pal did not depose Ms. Hamade during fact discovery because T-Mobile belatedly disclosed her and hid her relevance.

T-Mobile first disclosed Ms. Hamade on 11/17/2022—four months after T-Mobile served its Final Invalidity Contentions and just 15 days before the then-close-of-fact discovery. EX2 at 3. At that time, VoIP-Pal was in the midst of deposing T-Mobile’s 30(b)(6) designees. T-Mobile, however, refused to designate a witness to testify regarding VoIP-Pal’s 30(b)(6) Topic No. 24, which sought the factual basis of T-Mobile’s affirmative defenses including invalidity. EX3 at 25. Despite VoIP-Pal’s objections, T-Mobile also refused to disclose which of the 108 references identified in T-Mobile’s invalidity contentions it intended to rely on by the 11/15/2022 case-narrowing deadline. EX4 at 1-2; Dkt. 30 at 6. T-Mobile further did not seek leave to add an inequitable conduct defense based on HotSpot@Home until 2/6/2022—four days after fact discovery ultimately closed. Thus, -T-Mobile hid Ms. Hamade’s relevance to its defenses. EX5 at 14-20. That did not become apparent until T-Mobile served its invalidity expert report on 2/9/2023, which narrowed T-Mobile’s asserted prior art to just HotSpot@Home. VoIP-Pal first requested a deposition of Ms. Hamade at that time but T-Mobile refused. EX6.

T-Mobile refuses to produce Ms. Hamade because it claims that VoIP-Pal did not seek to depose Ms. Hamade before fact discovery closed. The Court should not condone such gotcha tactics. As noted above, VoIP-Pal did not know that T-Mobile intended to rely *only* on HotSpot@Home until T-Mobile served its invalidity expert report. Additionally, VoIP-Pal *did* seek a 30(b)(6) witness to testify regarding the factual basis of T-Mobile’s defenses, which T-Mobile refused to provide. By using Hamade to buttress its invalidity case after the fact discovery deadline, T-Mobile invited further discovery and should not be allowed to exploit the deadline by denying VoIP-Pal the opportunity to cross examine Ms. Hamade on belatedly disclosed facts. Moreover, T-Mobile is prolonging fact discovery by seeking continued depositions of inventors Bjorsell and Malak, which are scheduled for September.

Courts have allowed depositions of fact witnesses when a party's expert relies on conversations with the witness in forming his or her opinions. *See Oracle America, Inc., v. Google Inc.*, No. 3:10-cv-03561-WHA, Dkt. 712 (N.D. Cal. Feb. 9, 2012); *see also* Fed. R. Civ. P. 26(a)(2)(B) (requiring disclosure of facts considered by expert in forming opinions). Courts also have allowed depositions of witnesses who submit a declaration in opposition to a summary judgment motion. *See, e.g., Viamedia, Inc. v. Comcast Corp.*, 2022 U.S. Dist. LEXIS 43964 (N.D. Ill. Mar. 11, 2022). This Court's ruling in *Koss* is inapplicable because the nonmoving party did not introduce new facts through its witness after fact discovery closed as T-Mobile has.

Relief Requested: Accordingly, VoIP-Pal respectfully requests that the Court Order that “VoIP-Pal's Request to compel T-Mobile to produce Ms. Nayla Hamade for a deposition regarding her conversations with T-Mobile's technical expert and her declaration in support of T-Mobile's Opposition to VoIP-Pal's Motion for Summary Judgment of No Invalidity is GRANTED. T-Mobile shall produce Ms. Hamade for deposition within 14 days of this Order.”

T-Mobile's Position

VoIP-Pal chose not to depose Ms. Hamade during fact discovery. Now it demands a deposition *six months after fact discovery's close* and after completing summary judgment briefing. VoIP-Pal's request should be denied.

Ms. Hamade's relevance was clear from the outset. HotSpot@Home is T-Mobile's own prior-art calling system *and* the basis for its inequitable conduct claim (VoIP-Pal knew about and used HotSpot@Home in 2006, and made a specific decision not to disclose it to the PTO). VoIP-Pal long concealed these actions with illegitimate privilege claims and delayed productions/depositions, and now—incredibly—uses its delays to blame **T-Mobile** for VoIP-Pal's professed failure to understand HotSpot@Home's significance.

T-Mobile disclosed HotSpot@Home in Defendants’ shared invalidity contentions on 7/26/2022, EX7, and disclosed Ms. Hamade, *specifically noting her knowledge of HotSpot@Home*, as one of only a handful of witnesses on 11/17/2022. EX2 at 3. Ms. Hamade’s name also appears in produced HotSpot@Home documents. Nobody has “hid[den] Ms. Hamade’s] relevance.”

Nor was her disclosure “belated.” Fact discovery closed February 2, 2023 (Dkt. 81), giving VoIP-Pal not 15 but **77 days** to take Ms. Hamade’s deposition. VoIP-Pal never asked to. Nor did it seek relief after seeing T-Mobile’s invalidity expert report, or before completing summary judgment briefing.

VoIP-Pal never moved to compel testimony for its catch-all 30(b)(6) topic. Overbroad Topic 24 demanded generic testimony regarding “the factual bases of Your affirmative defenses and counterclaims.” It does not mention invalidity, much less HotSpot@Home. T-Mobile timely objected to this improper topic (EX8); the parties conferred; and VoIP-Pal then understandably dropped the issue.

Similarly, T-Mobile was not required to narrow to one prior-art reference during fact discovery, but—if VoIP-Pal wanted to complain about this—it should have done so last November.

VoIP-Pal’s cited cases do not support late depositions. *Viamedia*, for instance, involved undisclosed theories—not at issue here. In fact, *Viamedia* approvingly cites a case denying depositions where the movant waited until post-summary judgment briefing to seek relief. *Jugobanka d.d N.Y. Agency v. Unis Int’l Corp.*, No. 93C1865, 1194 U.S. Dist. LEXIS 18820, at *2 (N.D.Ill. 1/5/1995) (denying depositions where movant “provided no justification for why it has not attempted to discover and depose these individuals previously”). Moreover, VoIP-Pal

ignores this Court's precedent denying a motion to compel out-of-time depositions for timely-disclosed witnesses. *Koss Corp. v. Apple, Inc.*, No. 6:20-cv-665, Dkt. 145 (W.D.Tex. 3/2/2022); *see also Image Processing Techs. v. Samsung*, No. 2:20-cv-50-JRG, Dkt. No. 194 (E.D.Tex. 6/20/2020) (denying motion to strike expert's reliance on timely-disclosed witness).

That VoIP-Pal has successfully long delayed Court-ordered supplemental depositions of its witnesses (2/23/23 Order, Dkt. 95) is also no justification for permitting an out-of-time T-Mobile deposition. Limited fact discovery continues for VoIP-Pal witnesses because of VoIP-Pal's litigation shenanigans; that is not a basis for punishing T-Mobile with a late deposition that VoIP-Pal previously chose to forgo.

Finally, Rule 26 provides VoIP-Pal no relief. T-Mobile's expert properly disclosed facts he learned from Ms. Hamade. VoIP-Pal could have discovered these facts, had it been diligent. It was not; it must live with the consequences.

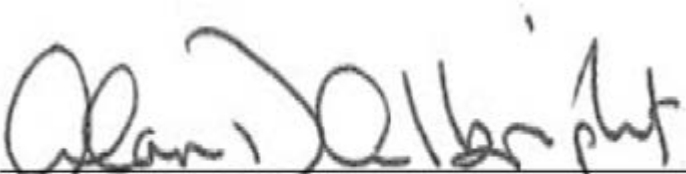
Relief Requested: Order that VoIP-Pal's Request to compel T-Mobile to produce Ms. Nayla Hamade for a deposition is DENIED. In the alternative, if the Court grants VoIP-Pal's requested relief, order that VoIP-Pal must bear all costs and fees associated with preparing for and presenting Ms. Hamade for her deposition.

Resolution

After reviewing the parties' positions, case file, and applicable law, the Court **GRANTS-IN-PART** VoIP-Pal's requested relief, as follows:

T-Mobile shall produce Ms. Nayla Hamade for a deposition not to exceed three hours and limited in scope to her conversations with T-Mobile's technical expert and her declaration in support of T-Mobile's Opposition to VoIP-Pal's Motion for Summary Judgment of No Invalidity.

SIGNED this 3rd day of October, 2023.



ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE